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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,631	09/30/2003	Kenneth D. Nelson	T-6133 (538-56)	6068

7590 01/03/2007
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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
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1714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/675,631

Applicant(s)

NELSON ET AL.

Examiner

Patrick D. Niland

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/11/06
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/20/06</u> | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1714

1. The finality of the office action of 9/11/06 is withdrawn in view of the following new grounds of rejection.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-75 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4601837 Valcho et al..

Valcho discloses solutions or dispersions made by mixing hydrated polymolybdates and oil where the polymolybdate is the major part of the dispersed phase and which may include polybutene succinic anhydride to improve clarity (column 2, lines 3-68, particularly 32-35; column 3, lines 1-68, particularly 51-68; column 4, lines 1-68, particularly 1-21, 45-48, and 58-60; column 5, lines 1-68, particularly 19-29 and 30-47; column 6, lines 1-68, particularly 1-14, 26-39, and 64-68; column 7, lines 1-68, particularly 1-58 and 64-68; column 8, lines 1-35, particularly 27-35 and 38-68; column 9, line 1 to column 15, line 22; and the remainder of the document. It is the examiner's position that the compositions of the patentee of the polymeric molybdates fall within the scope of the instantly claimed "colloidal suspensions" because of the nature of the molybdates and the oil phase of the patentee. It would appear that the conditions

Art Unit: 1714

using molybdenum oxides and acids of the patentee with heating would be sufficient to give the polymerizations required of the instant claims. The patentee is silent regarding turbidity. The reference to "clarity" when the succinate is used implies lack of turbidity. It is therefore expected that the instantly claimed turbidities are possessed by the patentee's compositions. The patentee is silent regarding particle size. Since the molybdates of the patentee are treated to increase their compatibility with the oil phase and can contain emulsifiers, such as the succinate referenced above, it is expected that their particle size is minimal and within the scope of the instant claims. All of the components of the patentee having hydrophilic and hydrophobic moieties fall within the scope of the detergents of the instant claims. The cations of the patentee will associate with the sulfonates thereby making the calcium sulfonate of the instant claims where calcium is present with sulfonate (column 7, line 43).

5. Claims 1-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4601837 Valcho et al..

Valcho discloses solutions or dispersions made by mixing hydrated polymolybdates and oil where the polymolybdate is the major part of the dispersed phase and which may include polybutene succinic anhydride to improve clarity (column 2, lines 3-68, particularly 32-35; column 3, lines 1-68, particularly 51-68; column 4, lines 1-68, particularly 1-21, 45-48, and 58-60; column 5, lines 1-68, particularly 19-29 and 30-47; column 6, lines 1-68, particularly 1-14, 26-39, and 64-68; column 7, lines 1-68, particularly 1-58 and 64-68; column 8, lines 1-35, particularly 27-35 and 38-68; column 9, line 1 to column 15, line 22; and the remainder of the document. It is the examiner's position that the compositions of the patentee of the polymeric molybdates fall within the scope of the instantly claimed "colloidal suspensions" because of the

Art Unit: 1714

nature of the molybdates and the oil phase of the patentee. It would appear that the conditions using molybdenum oxides and acids of the patentee with heating would be sufficient to give the polymerizations required of the instant claims. The patentee is silent regarding turbidity. The reference to "clarity" when the succinate is used implies lack of turbidity. It is therefore expected that the instantly claimed turbidities are possessed by the patentee's compositions. The patentee is silent regarding particle size. Since the molybdates of the patentee are treated to increase their compatibility with the oil phase and can contain emulsifiers, such as the succinate referenced above, it is expected that their particle size is minimal and within the scope of the instant claims. All of the components of the patentee having hydrophilic and hydrophobic moieties fall within the scope of the detergents of the instant claims. The cations of the patentee will associate with the sulfonates thereby making the calcium sulfonate of the instant claims where calcium is present with sulfonate (column 7, line 43).

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to mix the components of the instant claims via the processes of the instant claims from the disclosure of the patentee which encompasses these ingredient mixtures and processing conditions and would have been expected to give suspensions of the polymolybdates in oil having the clarity described by the patentee.

6. Claims 1-2, 5-11, 14-19, 22-23, 26-35, 37, 39-44, 49, 51, 54-63, 69, and 72-75 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4647388 Schreiber.

Schreiber discloses the instantly claimed suspensions and methods of making them at column 1, lines 49-68; column 2, lines 1-68, particularly 33-45, of which the conditions appear to be sufficient to polymerize the molybdic acid and drive off water, and 64-68; column 3, lines 1-

Art Unit: 1714

68, particularly 1-2, 17-19, and 20-25; column 4, lines 1-68, particularly 15-20; and the remainder of the document. It is not seen that heating the molybdic acids of the patentee according to the patentee do not give the polymerizations thereof required of the instant claims.

The compositions of the patentee are described as "solution or suspension". It is the examiner's position that "solution" implies the clarity required by the instant claims. It is ordinary to call those compositions which appear clear solutions and those which appear hazy suspensions or dispersions though solutions have particles of the polymolybdate dispersed throughout a continuous oil phase and are thus suspensions or dispersions. The patentee is silent regarding particle size. Since the molybdates of the patentee are treated to increase their compatibility with the oil phase and can contain emulsifiers, such as the sulfonates of column 2, lines 64-68, it is expected that their particle size is minimal, particularly in the "solutions", and within the scope of the instant claims. All of the components of the patentee having hydrophilic and hydrophobic moieties fall within the scope of the detergents of the instant claims.

7. Claims 1-2, 5-11, 14-19, 22-23, 26-35, 37, 39-44, 49, 51, 54-63, 69, and 72-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4647388 Schreiber.

Schreiber discloses the instantly claimed suspensions and methods of making them at column 1, lines 49-68; column 2, lines 1-68, particularly 33-45, of which the conditions appear to be sufficient to polymerize the molybdic acid and drive off water, and 64-68; column 3, lines 1-68, particularly 1-2, 17-19, and 20-25; column 4, lines 1-68, particularly 15-20; and the remainder of the document. It is not seen that heating the molybdic acids of the patentee according to the patentee do not give the polymerizations thereof required of the instant claims.

The compositions of the patentee are described as "solution or suspension". It is the examiner's

Art Unit: 1714

position that "solution" implies the clarity required by the instant claims. It is ordinary to call those compositions which appear clear solutions and those which appear hazy suspensions or dispersions though solutions have particles of the polymolybdate dispersed throughout a continuous oil phase and are thus suspensions or dispersions. The patentee is silent regarding particle size. Since the molybdates of the patentee are treated to increase their compatibility with the oil phase and can contain emulsifiers, such as the sulfonates of column 2, lines 64-68, it is expected that their particle size is minimal, particularly in the "solutions", and within the scope of the instant claims. All of the components of the patentee having hydrophilic and hydrophobic moieties fall within the scope of the detergents of the instant claims.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to mix the components of the instant claims via the processes of the instant claims from the disclosure of the patentee which encompasses these ingredient mixtures and processing conditions and would have been expected to give suspensions of the polymolybdates in oil having the properties described by the patentee.

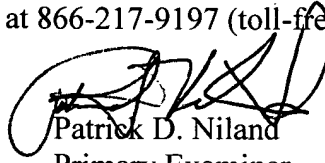
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

Art Unit: 1714

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick D. Niland
Primary Examiner
Art Unit 1714